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27683	7590	02/22/2006	EXAMINER	
HAYNES AND BOONE, LLP 901 MAIN STREET, SUITE 3100 DALLAS, TX 75202			SHAH, CHIRAG G	
			ART UNIT	PAPER NUMBER
			2664	

DATE MAILED: 02/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	09/697,822	RYAN, RONALD D	
	Examiner	Art Unit	
	Chirag G. Shah	2664	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 11/25/05.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-42 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-42 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 October 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |                                                                                                                        |                                                                                         |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                            | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____                                                |

## DETAILED ACTION

### *Response to Arguments*

1. Applicant's arguments with respect to claims 1-42 have been considered but are moot in view of the new ground(s) of rejection.
2. Applicant's submission of Affidavits to overcome the rejection under ETSI necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

*Claim Rejections - 35 USC § 102*

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-3, 5-8, 12, 14-15, 17, 18-20, 22-24 and 26 rejected under 35 U.S.C. 102(e) as being anticipated by Sjoblom (U.S. Publication 2002/0150096 A1).

Regarding claims 1 and 19, Sjoblom discloses in **abstract and fig. 3** of a method for lawful interception of communication related information comprising:

selecting a location for intercepting a communication in a packet data network based at least in part on an event type **[interception node-GSN Node or any other suitable node, which can be used for incorporating an interception function is defined in terms of selection and location, see paragraph 0060; claim 10, lines 3-4; and figs. 1 and 3]**;

detecting the occurrence of a predetermined event in said packet data network **[see fig. 3 and paragraph 0061-0062, where the interception related information (IRI) detector 32 is adapted to detect interception related information data packets and CC detector 33 is adapted to detect the communication contents of the communication to be intercepted]**;

gathering communication relating information of said communication at said selected location in response to said detection of the occurrence of said event **[see paragraph 0064 and 0076 and claim 10, lines 17-20, an ordering data generating means for providing ordering**

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**data for each of the interception related information data packets for transmission to the interception authority device]; and**

transmitting said gathered communication related information to at least one law enforcement agency [*see paragraph 0065, fig. 3 and claim 10, lines 21-25, of a transmitting means for transmitting the interception related information packets and communication content packets to the interception authority device*].

Regarding claim 26, Sjoblom discloses in **abstract and fig. 3** of a system for lawful interception of communication related information comprising:

selecting a location for intercepting a communication in a packet data network based at least in part on an event type [**interception node-GSN Node or any other suitable node, which can be used for incorporating an interception function is defined in terms of selection and location, see paragraph 0060; claim 10, lines 3-4; and figs. 1 and 3**];

means [IRI detector 32, fig. 3] for detecting the occurrence of a predetermined event in said packet data network [*see fig. 3 and paragraph 0061-0062, where the interception related information (IRI) detector 32 is adapted to detect interception related information data packets and CC detector 33 is adapted to detect the communication contents of the communication to be intercepted*];

means [IRI ordering, fig. 3] for gathering communication relating information of said communication at said selected location in response to said detection of the occurrence of said event [*see paragraph 0064 and 0076 and claim 10, lines 17-20, an ordering data generating*

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**means for providing ordering data for each of the interception related information data packets for transmission to the interception authority device]; and**

**means [transmitter 37, fig. 3] transmitting said gathered communication related information to at least one law enforcement agency [see paragraph 0065, fig. 3 and claim 10, lines 21-25, of a transmitting means for transmitting the interception related information packets and communication content packets to the interception authority device].**

Regarding claim 2, Sjoblom disclose in paragraph 0006 wherein the packet data network comprises a UMTS network.

Regarding claim 3, Sjoblom discloses in paragraph 0059-0060 wherein said interception is performed by a GSN node and or any other suitable node, which can be used for incorporating interception function, and AP node a discussed in paragraph 0059 may serve as Surveillance Access Point (SAP).

Regarding claim 5, Sjoblom discloses wherein said selecting a location comprises intercepting said communication at a serving node in said packet data network if the event is a path establishment or a path release [as disclosed in paragraph 0060, GSN Support node can be SGSN or GGSN; SGSN or GGSN performs interception when the event is to establish packet switched].

Regarding claim 6, Sjoblom discloses in wherein said serving node is selected from the group consisting of a SGSN and an E-SGSN.

Regarding claim 7, Sjoblom discloses in paragraph 0060, lines 1-4 wherein said selecting a location comprises intercepting said communication at a gateway node [GGSN, see 0060] in said packet data network if the event is transmission of a packet.

Regarding claim 8, Sjoblom discloses in paragraph 0060, lines 1-4 wherein said gateway node is selected from the group consisting of a GGSN and an E-GGSN.

Regarding claim 12, Sjoblom discloses in paragraph 0060-0061 herein said gathering communication related information includes gathering said communication related information based at least in part on said detected event [information related to intercepted packets].

Regarding claim 14, Sjoblom discloses wherein said gathered communication related information includes information related to path establishment or path release [see 0064, 0073, claim 10, lines 17-20, where telephone number, which relates to path establishment data is intercepted to be sent to the interception authority].

Regarding claim 15, Sjoblom discloses wherein said gathered communication related information includes packet information [see 0064, claim 10, lines 17-20, where

ordering/gathering information includes information related interception packets or call content and the order of packets relates to path establishment data in order to the interception authority].

Regarding claim 17, Sjoblom discloses in paragraph 0058-0059 wherein said path establishment information includes information indicating the status of a path between a mobile terminal and said packet network, wherein said information is selected from the group consisting of established and released.

Regarding claim 18, Sjoblom discloses in fig. 2 of header including wherein said packet information includes a source address and a destination address of a packet.

Regarding claim 20, Sjoblom disclose in paragraph 0006 wherein the packet data network comprises a UMTS network.

Regarding claims 22, Sjoblom discloses in fig. 2 and 3, 0058-0059 and claim 10 wherein said detected event is selected from the group consisting of the establishment of a path and release of a path; wherein said collected communication relating information includes a path related information, wherein said path related information is selected from the group consisting of path established and path released, wherein said collected information further includes information selected from the group consisting of a time stamp for the detection of the occurrence of said event, and a path identifier for said path.



Regarding claim 23, Sjoblom discloses in figure 2 and claim 10 wherein said detected event is transmission of a packet in said packet data network, wherein said packet includes a payload and a network layer [intercepted data, control network information], and wherein said collected communication related information includes information selected from the group consisting of source address of said packet and a destination address of said packet [see fig. 2 of header including wherein said packet information includes a source address and a destination address of a packet].

Regarding claim 24, Sjoblom wherein said information further includes information selected from the group consisting of a path identifier for a path utilized for said transmission of said packet and an address of a network service to which said packet is delivered prior to being delivered to said destination address [see fig. 2 of header including wherein said packet information includes a source address and a destination address of a packet].

### *Claim Rejections - 35 USC § 103*

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 9, 11, 13, 25 and 27-42 rejected under 35 U.S.C. 103(a) as being unpatentable over Sjoblom in view of Prieur (U.S. Patent No. 6,470,075).

Regarding claim 27, Sjoblom discloses in **abstract and fig. 3** of a system for lawful interception of communication related information comprising:

selecting a location for intercepting a communication in a packet data network based at least in part on an event type **[interception node-GSN Node or any other suitable node, which can be used for incorporating an interception function is defined in terms of selection and location, see paragraph 0060; claim 10, lines 3-4; and figs. 1 and 3];**

means [IRI detector 32, fig. 3] for detecting the occurrence of a predetermined event in said packet data network **[see fig. 3 and paragraph 0061-0062, where the interception related information (IRI) detector 32 is adapted to detect interception related information data packets and CC detector 33 is adapted to detect the communication contents of the communication to be intercepted];**

means [IRI ordering, fig. 3] for gathering communication relating information of said communication at said selected location in response to said detection of the occurrence of said event **[see paragraph 0064 and 0076 and claim 10, lines 17-20, an ordering data generating means for providing ordering data for each of the interception related information data packets for transmission to the interception authority device]; and**

means [transmitter 37, fig. 3] transmitting said gathered communication related information to at least one law enforcement agency **[see paragraph 0065, fig. 3 and claim 10, lines 21-25, of a transmitting means for transmitting the interception related information packets and communication content packets to the interception authority device].**

Sjoblom fails to disclose of a base station for receiving an event, a node operable to communicate with the base station and a SAP operable to communicate with the node, wherein

the SAP intercepts, gathers and provides the gathered information to the law enforcement agency.

Prieur teaches of a system and method for determining whether at least one subscriber participating in a communication session is marked for monitoring by a LEA.

Prieur discloses in figure 2 and respective portions of the specification of a base station [BS] for receiving an event from an intercept device [Intercept Access Point (IAP) 14] via MSC. As mentioned before, Prieur discloses in col. 3, lines 60 to col. 4, lines 7 and col. 4, lines 54-56, that IAP may be co-located with the MSC 16 or may be logically connected to MSC, in order to be able to intercept communications of monitored subscribers. Prieur further discloses in figure 2 of a node [target mobile station] operable to communicate with the base station [BS] and the MSC [logically connected to SAP (IAP)]. Prieur also discloses in col. 5, lines 49 to col. 6, lines 2, of SAP (IAP 14) intercepts the call content and the call identification information, which is then delivered through the delivery function 18 to the Law Enforcement Agency 30. Therefore, it would have been obvious to one of ordinary skills in the art at the time of the invention to modify the teachings of ETSI to include the features for performing the functionalities as taught by Prieur in order for the LEAs to find potentially incriminating information relating to the monitor subscribers in real-time without prolonged delays.

Regarding claims 9 and 25, Sjoblom discloses in figure 3 and claim 10 and respective portions of the specification wherein said transmitting said gathered communication related information further comprises: Sjoblom discloses in claim 10, lines 13-25 of providing said gathered information (interception relation information packets) to a delivery function (transmitter);

Sjoblom fail to explicitly disclose of formatting said gathered information by said delivery function into a format acceptable to said at least one law enforcement agency; and forwarding said formatted information to said law enforcement agency. Prieur discloses of formatting said gathered information by said delivery function into a format acceptable to said at least one law enforcement agency; and formatting said formatted information to said law enforcement agency [as disclosed in figure 2 and in col. 4, lines 54-56 and col. 5, lines 18-40 and 63-67, IAP intercepts communication of monitored subscribers and includes a module for formatting data and then forwarding the data to the delivery sub function<sup>18</sup> ; and providing said report to said law enforcement agency [as disclosed in col. 5, lines 63-67, the delivery function delivers the intercepted information of the monitored subscriber to LEA 30]. Therefore, it would have been obvious to one of ordinary skills in the art at the time of the invention to modify the teachings of Sjoblom to include formatting by delivery function into a format acceptable by law enforcement agency as taught by Prieur. One is motivated as such in order to legibly read call content and call identification information for the LEA to prosecute the applicable action.

Regarding claim 11, Sjoblom discloses in figure 3 and claim 10 and respective portions of the specification wherein said transmitting said gathered communication related information further comprises: Sjoblom discloses in claim 10, lines 13-25 of providing said gathered information (interception relation information packets) to a delivery function (transmitter); Sjoblom fails to explicitly disclose wherein said transmitting said gathered communication related information comprises: formatting said gathered information by said SAP into a report acceptable to said at least one law enforcement agency; and providing said report to said law

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enforcement agency. Prieur discloses in figure 2 wherein said transmitting said gathered communication related information comprises: formatting said gathered information by said SAP [IAP 14] into a report acceptable to said at least one law enforcement agency [as disclosed in figure 2 and in col. 4, lines 54-56 and col. 5, lines 18-40 and 63-67, IAP intercepts communication of monitored subscribers and includes a module for formatting data and then forwarding the data to the delivery sub function18; and providing said report to said law enforcement agency [as disclosed in col. 5, lines 63-67, the delivery function delivers the intercepted information of the monitored subscriber to LEA 30]. Therefore, it would have been obvious to one of ordinary skills in the art at the time of the invention to modify the teachings of Sjoblom to include formatting by delivery function into a format acceptable by law enforcement agency as taught by Prieur. One is motivated as such in order to legibly read call content and call identification information for the LEA to prosecute the applicable action.

Regarding claim 13, Sjoblom fails to disclose wherein said gathered communication related information includes information related to call signaling. Prieur discloses in col. 4, lines 8-24 wherein said gathered communication related information includes information related to call signaling [a call data channel may be used for carrying messages reporting the call-identifying information]. Therefore, it would have been obvious to one of ordinary skills in the art at the time of the invention to modify the teachings of Sjoblom to gathered communication related to call signaling. One is motivated as such in order to identify the what type of channel or signal may be used for transporting the intercepted call content, thus improving system latency.

Regarding claim 28, Prieur discloses in figure 2 wherein said base station is a Radio Access Network.

Regarding claim 29, Prieur discloses in figure 2 wherein said intercept device [mobile device] is a mobile terminal selected from the group consisting of a wireless phone, a personal digital assistant, and a pager.

Regarding claim 30, Sjoblom discloses in paragraph 0060, lines 1-3 wherein said node is a serving node.

Regarding claim 31, Sjoblom discloses in paragraph 0060, lines 1-4 wherein said node is a SGSN.

Regarding claim 32, Sjoblom discloses in paragraph 0059-0060 wherein said SAP is part of a node selected from the group consisting of a serving node[SGSN, see 0060] and a gateway node [GGSN, see 0060].

Regarding claim 33, Sjoblom discloses in paragraph 0060 wherein said SAP is part of a node selected from the group consisting of a serving GPRS support node, an extended serving GPRS support node, a gateway GPRS support node, and an extended gateway GPRS support node.

Regarding claim 34, Sjoblom discloses in fig. 2 and 3 wherein said gathered communication related information includes information about the initiation of a call setup [time stamp/control data/session identifier, fig. 2] by said intercept device [GSN intercept node, fig. 3].

Regarding claim 35, Sjoblom disclose in fig. 2 and 3 wherein said gathered communication related information includes information about the initiation of a session setup [session identifier and control data, fig. 2] by said intercept device [GSN intercept node, fig. 3].

Regarding claim 36, Sjoblom discloses wherein said gathered communication related information includes information about the establishment of a communication path between said intercept device and a network service [see 0064, 0073, claim 10, lines 17-20, where telephone number, which relates to path establishment data is intercepted to be sent to the interception authority].

Regarding claim 37, Sjoblom discloses wherein said gathered communication related information includes information about the release of a communication path between said intercept device and a network service [see 0064, 0073, claim 10, lines 17-20, where telephone number, which relates to path establishment and released data]

Regarding claim 38, Sjoblom discloses wherein said gathered communication related information includes the destination address of a packet transmitted over a communication path

between said intercept device and a network service [see fig. 2 of header including wherein said packet information includes a source address and a destination address of a packet].

Regarding claim 39, Sjoblom discloses in fig. 1 and 2 wherein said destination address is the address of said network service [LEA 1, fig. 1].

Regarding claim 40, Sjoblom discloses in fig. 1 and 2 wherein said destination address is the address of another device [2\_3 delivery function, fig. 1] associated with said network service [LEA, fig. 1] and said gathered information further includes an address of said network service [LEA, fig. 1], wherein said packet is delivered to said another device via said network service.

Regarding 41, Prieur discloses in figure 1 wherein said network service is associated with an Internet Service Provider (ISP) [Service Provider Administration Sub-function] as claim.

Regarding claim 42, Sjoblom discloses in fig. 1 and 2 wherein said destination address is the address of an associate device [deliver function, fig. 1].

7. Claims 4, 16 and 21 and rejected under 35 U.S.C. 103(a) as being unpatentable over Sjoblom in view of Hasan et al. (U.S. 6,707,813).

Regarding claims 4, 16 and 21, Sjoblom discloses in fig. 2 of GPRS related events information selected from the group consisting of a time stamp for the detection of the occurrence of the event, a session identifier, and an identifier of the type of the communication.



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Sjoblom fails to disclose wherein said call signaling information includes information indicating the type of signaling, wherein said information is selected from the group consisting of H.323 and SIP. Hasan teaches of a method of call control in a packet-switched radio telecommunications network. Hasan discloses in col. 2, lines 31-58 of utilizing CSCF to serve H.323 gatekeeper or a SIP proxy server. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of Sjoblom to include implementing call control protocols such as SIP and H.323 in order to minimize delays.

8. Claim 10 rejected under 35 U.S.C. 103(a) as being unpatentable over Sjoblom in view of Prieur further in view of Dikmen et al. (U.S. Patent No. 6577865), hereinafter Dikmen.

Regarding claim 10, Sjoblom in view of Prieur discloses of delivery function. Sjoblom in view of Prieur fails to explicitly disclose the delivery function utilizes a J-STD-025 interface. Dikmen teaches a system for intercepting of wireless communication. Dikmen discloses in col. 3, lines 66 to col. 4, lines 13, wherein the delivery function utilizes a J-STD-025 interface. Therefore, it would have been obvious to one of ordinary skills in the art at the time of the invention to modify the teachings of Sjoblom in view of Prieur to include utilizing a J-STD-025 interface as taught by Dikmen in order to be able to verify the connectivity of the call data channels (CDC), which are generally used to transport messages which report call-identifying information, such as calling party identities and called party identities.

*Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chirag G. Shah whose telephone number is 571-272-3144. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Huy Vu can be reached on 571-272-3155. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

cgs  
February 19, 2006



Chirag Shah  
Patent Examiner